



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,663	04/05/2001	Joseph Herbert McIntyre	AUS920010294US1	3501

7590

08/11/2004

Robert V. Wilder
Attorney at Law
4235 Kingsburg Drive
Round Rock, TX 78681

EXAMINER

AGDEPPA, HECTOR A

ART UNIT

PAPER NUMBER

2642

DATE MAILED: 08/11/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,663

Applicant(s)

MCINTYRE, JOSEPH HERBERT

Examiner

Hector A. Agdeppa

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-35 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's amendment filed on 6/1/04.

Claims 1 - 35 are now pending in the present application. **This action is made final.**

Double Patenting

2. Claims 1 – 35 are provisionally rejected under the judicially created doctrine of double patenting over claims 1 - 35 of copending Application No. 09/826,663 in the previous office action.

Examiner acknowledges that applicant agrees to execute and file a Terminal Disclaimer to obviate this rejection upon a determination of allowable claims. However, this office action does not indicate any allowable claims and so the rejection is respectfully maintained and incorporated by reference as set forth in the last office action.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1 - 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,160,877 (Tatchell et al.) in view of US 2002/0085687 (Contractor et al.)

Art Unit: 2642

As to claims 1 – 3 and 18 - 20, Tatchell et al. teaches a personal agent system which allows for the selective forwarding of calls received at, for example, a subscriber's office number, read as the claimed first number, to the subscriber's home number, read as the claimed second number. Forwarding only occurs if the incoming call is one of a predetermined calling parties, read as the claimed selected incoming telephone calls. All other incoming calling parties or those part of a different predetermined group are routed to another number, a voice mail system, or some other default termination. (Abstract, Col. 3, line 24 – Col. 5, line 2, Col. 9, line 29 – Col. 12, line 19, Col. 18, line 55 – Col. 22, line 33 of Tatchell et al.)

What Tatchell et al. does not teach displaying information on the subscriber's device and enabling a subscriber to input a second number on the device and displaying it.

However, Tatchell et al. teaches that the system and method may be implemented and accessed from a mobile telephone. (Col. 7, line 4 of Tatchell et al.) Mobile telephones inherently or at the least obviously have displays and have the ability to display such information as callerID information. In fact, Tatchell et al. teaches that such is well known. (Col. 1, lines 28 – 32, lines 49 – 53 of Tatchell et al.)

See the rejection of claim 7 below. While Tatchell et al. specifically teaches using voice recognition to circumvent the need for displays, as in presenting database and table information including selected phone numbers to be treated in certain ways, forwarded, etc., it still would have been obvious for

Art Unit: 2642

one of ordinary skill in the art at the time the invention was made to simply not have the system translate text to speech as is done. In such a situation, Tatchell et al. teaches that information will be announced to the subscriber and the subscriber, using voice recognition, can speak instructions to input selected numbers as well a number such selected numbers will be transferred to . (Col. 13, line 38 – Col. 18, line 23, Col. 20, lines 21 - 65 of Tatchell et al.)

Again, all that is required is to merely not translate the text. Arguably this is simplification of the invention of Tatchell et al. and therefore obvious.

Also, Contractor et al. teaches that while mobile phones typically require a user to look at a display and as is known, to enter information on the mobile device, this is sometimes inconvenient and it is safer (while driving for example) to interact with a mobile telephone audibly. (P. 1, ¶ 0004 of Contractor et al.) Any user of mobile telephones can access menus and provision selected telephone numbers to have specific handling characteristics. I personally use an AT&T mobile telephone that allows certain features to be applied to certain telephone numbers wherein all the interaction is done via visual displays and entering inputs via the mobile phone keypad.

Therefore, using audible methods and visual methods are old and well known and while there are motivations for using audible interaction, visual interaction is known and commonly used and therefore, it still would be obvious for one of ordinary skill in the art at the time the invention was made to use visual interaction in the invention of Tatchell et al.

Art Unit: 2642

Moreover, as to the claimed displaying said second number, whenever for example, a user enters anything on a mobile telephone keypad, a corresponding notation is displayed. If a user presses "XXX-XXX-XXXX", the mobile phone will display that telephone number.

As to claims 4 and 21, personal agent 11 is basically a processor that can either be co-located with a telephone switching center 10, or located on its own. Moreover, it contains at least an application processor 21 and various databases 22. (Figs. 1 and 2a) As such, personal agent 11 is analogous to the claimed server.

As to claims 5 and 22, Tatchell et al. teaches that a subscriber of the personal agent can access the personal agent and perform any and all function available therefrom, including provisioning the subscriber's databases wherein the selected callers/numbers are identified, from any device, remote or local. (Col. 3, lines 60 – 63, Col. 7, lines 15 – 32, Col. 8, line 5 – Col. 9, line 28)

As to claims 6 and 23, see Col. 12, line 67 – Col. 13, line 29. Also see the rejection of claims 4 and 21, wherein it is taught that such information is stored in the personal agent's databases. Therefore, it is inherent that the selected information would have to be sent to personal agent/ server 11, since a subscriber will always access the personal agent only over a telephony device.

As to claims 7 – 9 and 24 – 26, see the rejection of claim 1. Again, Tatchell et al. does not teach the use of a visual display for menus when interacting with personal agent 11. Tatchell et al. instead, teaches using voice recognition as the mode of interaction between the system and subscriber.

Art Unit: 2642

However, such is old and well known and it would have been obvious for one of ordinary skill in the art to have implemented visual displays in the invention of Tatchell et al. inasmuch as such a feature is merely a design choice or preference which is based on user functionality not having patentable relevance to the invention feature of the present invention, selective call forwarding. One motivation for having visual menus and interaction is because long lists of messages or intricate menus, for example, could be tedious and confusing to navigate via telephone key buttons or via voice. Therefore, certain inventions have chosen to use visual menu displays. On the other hand, visual displays also present a old and well known problem, especially in the mobile telephony arts, in that when driving a car, for example, having to look at and navigate a menu visually is quite dangerous. In such a scenario, audio interaction, such as voice recognition means, are a much safer way to interact with a device/system. As such, again, it is merely a design choice.

As to claims 10, 11, 27, and 28, see Col. 12, lines 58 – 66, Col. 13, line 38 – Col. 16, line 47. Because Tatchell et al. teaches that a subscriber may categorize contact numbers in their database, such reads on selecting numbers from the entire database, as well as “designating” them.

As to claims 12 and 14, Tatchell et al. teaches that the personal agent may be accessed/utilized from any telephony device such as a mobile phone, i.e., a wireless device/cellular phone. (Col. 7, lines 1 – 4)

Art Unit: 2642

As to claim 13, see Col. 7, lines 10 – 14 wherein Tatchell et al. teaches that either voice, or DTMF codes entered on the user device may be used to control, access, provision personal agent 11.

As to claims 15 – 17 and 33 – 35, Tatchell et al. does not teach using a pager or computer/laptop to access personal agent 11. However, in modern telecommunications systems, the integration of various types of telephony and computer devices is very old and well known. It would have been obvious for one of ordinary skill in the art at the time the invention was made to have contemplated using other devices besides strictly telephony devices to interact with personal agent 11. Tatchell et al. as discussed above, already contemplates using both landline and wireless telephones as well as receiving data and fax communications in addition to just voice communications. (Col.4 , line 34 and Col. 14, line 34, Col. 19, line 34)

As to claim 29, see the rejection of claims 1, 4, 18 and 21. Furthermore, personal agent 11 has therein, at least, a processor 21 and various databases which communicate with each other. Databases and processors are not the same type of elements, nor do they perform the same operations. As such, it is inherent that a network interface would have to be used to allow for those two different types of elements to interact.

What Tatchell et al. does not teach is the use of a system bus. However, system busses are extremely old and well known and merely allow different components of a system to be connected to a common link allowing for communication therebetween. Therefore, it would have been obvious for one of

Art Unit: 2642

ordinary skill in the art at the time the invention was made to have implemented personal agent 11 of Tatchell et al. in manner that utilized a system bus. The functionality and operation of personal agent 11 would not be affected by the use of a system bus as opposed to separate connections between the databases 22 and the processor 21. Moreover, Tatchell et al. does not even describe the type of connections used in personal agent 11. It could very well be that a system bus is used.

As to claims 30 and 32, see the rejection of claims 12 and 14.

As to claim 31, see the rejection of claim 13.

Response to Arguments

4. Applicant's arguments with respect to claims 1 - 35 have been considered but are moot in view of the new ground(s) of rejection.

While applicant argues that using visual displays in the invention of Tatchell et al. would render it inoperable, see the rejection above and note that the only modification that must be made is to not translate text into speech. In fact, such is a simplification of the invention of Tatchell et al. and would only require that one of ordinary skill in the art choose not to implement one step in the operation process. If a feature was enhanced by the introduction of a further step, i.e., translating text to speech, as taught by Tatchell et al., the prior operation, NOT translating the text and merely allowing visual display of information, was contemplated and known. A designer HAD to "choose" to go that extra step. Therefore, in this case, presenting visual information and

Art Unit: 2642

allowing visual interaction would have been obvious. It has been held that eliminating an element and/or its function from the prior art does not rise to the level of patentability. See *Ex parte Wu*, 10 USPQ2031 (Bd. Pat. App. & Inter. 1989).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,946,386 (Rogers et al.) teaches a call management system and method wherein incoming calls are displayed to a user along with certain information such as callerID information, and a user is able to input a choice corresponding to a desired call treatment.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

Art Unit: 2642


the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hector A. Agdeppa whose telephone number is 703-305-1844. The examiner can normally be reached on Mon thru Fri 9:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.A.A.
July 26, 2004


AHMAD MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600